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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,278	09/12/2003	Akira Horikoshi	06920/0200052-US0	7615

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NEW YORK, NY 10150-5257

EXAMINER
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HALE, GLORIA M

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 03/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/661,278	Applicant(s) HORIKOSHI ET AL	
	Examiner Gloria Hale	Art Unit 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08).<br>Paper No(s)/Mail Date <u>11-14-03</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: In line 4 the recitation "formed by belt-like cloth along the penis" is confusing in that it describes the upper piece in view of the wearer's body part and it is not clear as to how the upper piece relates to other components of the garment. In line 12 the "upper left and right" should be referred to as "an upper left and right" and are better recited as "corners" or "portions". Appropriate correction is required.

However, the claims, as best understood, have been examined on their merits.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flesh (US 2,050,410) in view of Baer (US 2,050,410).

In regard to claims 1-3 Flesh discloses a male supporter fitted to an inner part of male underpants, nether garment and trunks with a lower piece (lower portion 15) which covers the scrotum; an upper piece (upper portion 15); suspending devices (16) connected to both left and right edges (at 19), an axis device (14) which connects the back edge of the lower piece to an inner crotch (at 13) and the top edge of the upper piece connected to an upper central part (at 20) by suspending devices 16. (See Flesh,

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figures 1-4 and page 2, line 31 – page 2, col. 1, line 15). However, Flesh does not specifically disclose the axis device (14) as being elastic. Baer discloses the garment as being of a 2-way stretch material which renders the garment elastic as broadly claimed. Accordingly it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the Flesh garment of a 2-way stretch elastic material to provide stretch ability and comfort to the wearer. Constructing the Flesh garment of 2-way stretch material would render the axis portion 14 also elastic for increased comfort to the wearer. In regard to claim 2 the Flesh garment has a lower piece peripheral edge that is circle shaped to envelope the scrotum.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flesh in view of Baer as discussed above in regard to claim 1 and further in view of Choi (US 5,226,179).

Flesh and Baer disclosed the invention substantially as claimed. However, Flesh and Baer do not specifically disclose a penis retaining member on an inner part of the upper piece. Choi discloses a penis retaining piece 2 as seen in figures 1-3 and as described in col. 2, lines 48-63 to retain the penis in place to prevent it from chafing on the undergarment and to separate it from the skin of the wearer for improved circulation. Accordingly it would have been obvious to one having ordinary skill in the art at the time the invention was made to attach a retaining band on the inner surface of the Flesh undergarment to retain the penis as disclosed by Choi to separate the penis away from the body of the wearer for improved circulation.

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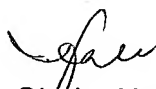
**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria Hale whose telephone number is 703-308-1282. The examiner can normally be reached on Tuesday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gloria Hale  
Primary Examiner  
Art Unit 3765

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